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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,584	02/28/2002	Robert J. Ward	INVSC.4	9027
7590	09/22/2004		EXAMINER	
Robert J. Ward			MAI, TRI M	
3313 Hidalgo Street				
Irving, TX 75062			ART UNIT	PAPER NUMBER

3727

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/086,584	WARD ET AL.
	Examiner Tri M. Mai	Art Unit 3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-55 and 57-61 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-55 and 57-61 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>04/11/03</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

### **DETAILED ACTION**

1. The specification is objected to: “a coupling” has no antecedent basis in the specification.
2. Claims 44-55, and 57-61 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original specification does not teach:
  - a. The outer cushioned layer operable to be squeezed and operable to return to the original shape (cl. 59)
  - b. The cushion layer being operable to be squeezed adjacent the opening to adjust for the grip (cl. 61)
  - c. The squeezing of the outer layer to deform the inner layer (cl. 44-61)
  - d. The absorbent member being moisture absorbent.
  - e. The original specification does not specify that cloth (cl. 45), leather (cl. 51), closed-cell foam (cl. 47), nylon (claim 50) being waterproof.

This is a new matter rejection.

Furthermore, the specification fails to show what comprises the compound in claim 55.

3. Claims 44-55, and 57-61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what comprises the coupling as claimed. The term has no antecedent basis in the specification.

It is unclear where is the cloth material in claim 46. Applicant is required to point out this element in the elected embodiment.

***Claim Rejections - 35 USC § 102/103***

4. Claims 44, 45, 50, 51, 53, 54, 55, 59, 60 and 61 are rejected under 35 U.S.C. 102(b) as being anticipated by Young (3406419). Young teaches a cover having a Eckstein teaches an outer cushion material (col. 2, ln. 30), and an inner absorbent material (col. 2, ln. 47).

Regarding claim 51, note the leather (col. 1, ln. 42).

Regarding claim 55, note the various compounds in col. 2, ln 50-65.

Regarding claim 60, the cover in Young has an elliptical cross section as claimed.

5. Claims 46, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young. It would have been obvious to one of ordinary skill in the art to provide the outer cushioned being a cloth material or rubber as an alternative material for the cover.

6. Claims 47, and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young in view of Price. It would have been obvious to one of ordinary skill in the art to provide the outer cushioned being a closed cell foam in Young as taught by Price to provide an alternative material for the cover.

Regarding claim 60, in the alternative, it would have been obvious to one of ordinary skill in the art to provide a elliptical shape at the opening in Young as taught by Price to provide the desired opening for the cover.

7. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Young in view of Kinsey (6463971). Kinsey teaches that it is known in the art to provide a logo and/or brand name on a cover (col. 3, ln. 30). It would have been obvious to one of ordinary skill in the art to provide a logo and/or brand name on the cover in Young as taught by Kinsey to promote the cover to the consumer.

8. Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Young in view of Thompson (4378832). Thompson teaches that it is known in the art to provide vents 24-29. It would have been obvious to one of ordinary skill in the art to provide vents in Young as taught by Thompson to provide ventilation.

9. Claims 44, 45, 50, 53, 57-59, 61 are rejected under 35 U.S.C. 102(b) as being anticipated by Eckstein, or in the alternative, over Eckstein (5203390) in view of Bucher (5118107). Eckstein teaches an outer cushion material (nylon), and an inner absorbent material (terry cloth fabric).

With respect to the coupling, as best understood view of the 112 matters above, the attachments at portions 82, 46, 50 are the couplings as claimed.

In the alternative, it would have been obvious to one of ordinary skill in the art to provide the coupling 37 in Eckstein as taught by Bucher to store the club and/or the cover easily.

The modified cover of Eckstein would meet the steps as set forth in the method claim 57.

10. Claims 46, 47, 50, 51, 52, 54 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable Eckstein. It would have been obvious to one of ordinary skill in the art to provide the outer cushioned layer from cloth, closed-cell foam, or leather to provide alternative material.

Regarding claim 60, it would have been obvious to one of ordinary skill in the art to provide an elliptical opening to provide the desired opening for the cover.

11. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eckstein in view of Kinsey (6463971). Kinsey teaches that it is known in the art to provide a logo and/or brand name on a cover (col. 3, ln. 30). It would have been obvious to one of ordinary skill in the art to provide a logo and/or brand name on the cover in Eckstein as taught by Kinsey to promote the cover to the consumers.

12. Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eckstein rejections, as set forth above, and further in view of Jones (2984486). Jones teaches that it is known in the art to provide vents on a handle sleeve. It would have been obvious to one of ordinary skill in the art to provide vents in Eckstein as taught by Jones to provide proper ventilation.

Jones teaches that it is known in the art to provide rubber and other plastic. It would have been obvious to one of ordinary skill in the art to provide rubber and equivalent materials in Eckstein as taught by Jones to provide alternative material for the cover.

13. Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Eckstein in view of Sullivan, Jr. (3147012). Eckstein meets all claimed limitations except for the compound to impart a tacky grip. Sullivan teaches that it is known in the art to wet the handle (col. 2, line 62). It would have been obvious to one of ordinary skill in the art to wet the handle in Eckstein as taught by Sullivan, Jr. to hold the grip securely.

***Response to Arguments***

14. Applicant's arguments filed have been fully considered but they are not persuasive. The claims do not over the 112, 1<sup>st</sup> paragraph rejection on the new matters. With respect to the rejection over Eckstein, it is noted that the coupling at the end of Eckstein are not sealing fasteners as claimed.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri M. Mai whose telephone number is (703)308-1038. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W Young can be reached on (703)308-2572. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tri M. Mai  
Primary Examiner  
Art Unit 3727

